

EA



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/618,300	07/11/2003	Maria Check	AND/ 002	4326

1473 7590 09/08/2005

FISH & NEAVE IP GROUP
ROPES & GRAY LLP
1251 AVENUE OF THE AMERICAS FL C3
NEW YORK, NY 10020-1105

EXAMINER

GREEN, BRIAN

ART UNIT	PAPER NUMBER
----------	--------------

3611

DATE MAILED: 09/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

HC

Office Action Summary

Application No.

10/618,300

Applicant(s)

CHEEK ET AL.

Examiner

Brian K. Green

Art Unit

3611

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 3/8/2005, 6/16/2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-51 is/are pending in the application.
- 4a) Of the above claim(s) 8-10, 16, 21, 22, 30-40 and 49-51 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3-7, 11-15, 17-20, 23-29, 41-48 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

Applicant's election with traverse of Species 1B in the reply filed on June 16, 2005 is acknowledged. The traversal is on the ground(s) that the claims 1,3-7,1-15,17-20,23-29, and 41-51 should be construed in the context of the entire specification as filed, not just the elected species. The examiner agrees that claims which are generic to other species are construed in the context of the entire specification. However, this argument is not sufficient to show that the examiner's election requirement is improper. The applicant failed to indicate or provide evidence that the species are obvious variants or clearly admit on the record that this is the case.

The requirement is still deemed proper and is therefore made FINAL.

New claims 49,50 and 51 are drawn to a non-elected species and therefore have been withdrawn. New claims 49,50, and 51 are similar to claims 8,9, and 10 which were withdrawn in the last office action as being directed to a non-elected species.

Claims 8-10,16,21,22,30-40,49,50, and 51 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1,3,11,15,17,19, and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Lithwick (U.S. Patent No. 4,951,404).

Lithwick shows in figures 1-8 a greeting card comprising a first and second sheet segment (11 or just 40,12) folded about a fold line (19), an aperture (21) in the first sheet segment (11), a first transparent containment sheet (26), a second transparent containment sheet (25), the first and second sheets forming a container, and a substance (23) in the container. In regard to claim 3, Lithwick shows in figures 4 and 5 that the first containment sheet (26) is attached to one side (the outer side of the sheet segment) of the first sheet segment and the second containment sheet (25) is attached to the other side (the inner side of the sheet segment) of the first sheet segment. In regard to claim 11, the second containment sheet (15) is considered to be part of a third sheet segment (39) that is folded about a second fold line (18). In regard to claim 15, the aperture (21) is non-circular. In regard to claim 17, Lithwick discloses in column 3, lines 35-39 the idea of placing indicia (picture) on the second containment sheet. In regard to claim 19, the container of Lithwick is capable of performing the function of being opened, i.e. the container can be cut or the first and second containment sheets can be pulled apart to allow the substance to be removed from the container. In regard to claim 20, the container of Lithwick is capable of performing the function of having the container re-sealed, i.e. placing a piece of tape over the cut that was placed in the container to allow the substance to be removed or adding additional adhesive to the container to allow the container to be re-sealed after separating the two containment sheets to allow the substance to be removed.

Claims 24,25, and 41-44 are rejected under 35 U.S.C. 102(b) as being anticipated by Jacobson et al. (U.S. Patent No. 3,191,340).

In regard to claim 24, Jacobson et al. shows in figures 1-6 a "greeting card" comprising a first and second sheet segment (2,4) folded about a fold line (the fold line between sheet segments 2 and 4), a special effects container (5) attached to the first sheet segment, the special effects container comprising at least one containment sheet (the planar bottom sheet of container 5, see figure 6) that is substantially flat, and a substance (55) housed in the special effects container, wherein at least a portion (the upper wall of the container is transparent) of the special effects container is transparent. In regard to claim 25, the substance (55) are considered to be special effects particles. In regard to claim 41, Jacobsen et al. shows in figures 1-6 a "greeting card" comprising a first sheet segment (4), a second sheet segment (2), wherein the first and second sheet segments are separated by a first fold line, a third sheet segment (3), wherein the second and third sheet segments are separated by a second fold line, an aperture (10) defined in the second sheet segment, and a transparent containment sheet (the outer sheet of container 5) affixed to the second sheet segment so that the transparent containment sheet covers the aperture, wherein the first and second sheet segments are affixed together to form a container, see column 2, lines 38-40. In regard to claims 42 and 43, Jacobsen et al. discloses that the sheet segments are affixed together in column 2, lines 38-40, and due to the cut-out in sheet segment (3), all the segments would be attached to one another around the perimeter of the second sheet segment as well as the perimeter of the aperture. In regard to claim 44, Jacobsen et al. shows a substance (55 or 15) within the container.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 14 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lithwick (U.S. Patent No. 4,951,404).

In regard to claim 14, Lithwick does not disclose making the aperture circular. Lithwick discloses the idea of making the aperture rectangular but also discloses in column 3, lines 45-47 that the shape of the container (shape of container matches the shape of the aperture) is optional. It would have been an obvious matter of design choice to make the aperture circular since the applicant fails to define any advantage to making the aperture round and the shape taught by Lithwick would work equally well. In regard to claim 18, Lithwick does not disclose making the indicia in the form of a snowman. Lithwick discloses the idea of making the indicia in the form of a cat. It would have been an obvious matter of design choice to make the aperture circular since the applicant fails to define any advantage to making the aperture round and the shape taught by Lithwick would work equally well. Further, it is considered within one skilled in the art to make the indicia in any form as desired. The indicia defined by the applicant is not functionally related to the substrate and therefore does not distinguish the invention from the prior art. See *In re Gulack*, 703 F.2d 1381, 217 USPQ 401 (Fed. Cir. 1983).

Claims 4-7 and 12-14 rejected under 35 U.S.C. 103(a) as being unpatentable over Lithwick (U.S. Patent No. 4,951,404) in view of Hirsch (U.S. Patent No. 6,484,425).

In regard to claim 4, Lithwick does not disclose the idea of making the substance within the container in the form of glitter. Hirsch shows in figures 1-4 a display that includes an aperture in a sheet which receives a transparent container (11) which includes a liquid and particles therein. Hirsch discloses in column 4, lines 15-20 that the particles can be glitter. In view of the teachings of Hirsch it would have been obvious to one in the art to modify Lithwick by making the substance in the container in the form of glitter since this would create a more amusing and aesthetically pleasing display. In regard to claim 5, Lithwick does not disclose the idea of making the substance within the container in the form of confetti. Hirsch shows in figures 1-4 a display that includes an aperture in a sheet which receives a transparent container (11) which includes a liquid and plurality of particles therein. Hirsch discloses in column 4, lines 15-20 that the particles can be glitter, colored plastic, pellets, chips, etc. The use of confetti is well known in the art. In view of the teachings of Hirsch and the fact that confetti is conventional in the art it would have been obvious to one in the art to modify Lithwick by making the substance in the container in the form of confetti since this would create a more amusing and aesthetically pleasing display. In regard to claims 6,7,12, and 13, Lithwick does not disclose the idea of placing liquid in the container and the idea of placing particles within the liquid. Hirsch shows in figures 1-4 a display that includes an aperture in a sheet which receives a transparent container (11) which includes a liquid and particles therein. Hirsch discloses in column 4, lines 15-20 that the particles can be glitter, plastic strips, colored plastic, sponge, rubber, metal, beans, pellets,

Art Unit: 3611

etc. In regard to claims 6 and 26, in view of the teachings of Hirsch it would have been obvious to one in the art to modify Lithwick by placing a liquid within the container since this would create a more amusing and aesthetically pleasing display. In regard to claims 7, 12, and 13, in view of the teachings of Hirsch it would have been obvious to one in the art to modify Lithwick by placing a liquid having particles within the container since this would create a more amusing and aesthetically pleasing display. In regard to claims 12 and 13, Hirsch discloses the use of both floating and sinking particles, see column 4, lines 15-25. In regard to claim 14, Lithwick does not disclose making the aperture circular. Hirsch shows in figure 2 the idea of making an aperture in a cover circular. In view of the teachings of Hirsch it would have been obvious to one in the art to modify Lithwick by making the aperture circular since this would create a more aesthetically pleasing display and it is considered within one skilled in the art to aperture in any shape as desired.

Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lithwick (U.S. Patent No. 4,951,404) in view of Fine et al. (U.S. Patent No. 6,438,878) or Gregory-Gillman (U.S. Patent No. 6,151,823).

Lithwick does not disclose the idea of tinting the first containment sheet. Fine et al. shows a display device in which the walls (140, 150) are tinted with a color, see column 5, lines 38-42. Gregory-Gillman discloses the use of a pocketed display device that includes a tinted front wall, see column 7, lines 28-36. In view of the teachings of Fine et al. or Gregory-Gillman it would have been obvious to one in the art to modify Lithwick by tinting the first containment sheet

Art Unit: 3611

since this would create a more amusing and aesthetically pleasing display and would help to protect the substance within the container from being damaged by the sun.

Claims 5 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lithwick (U.S. Patent No. 4,951,404) in view of Borden (U.S. Patent No. 5,197,213).

Lithwick does not disclose the idea of making the substance within the container in the form of confetti. Borden shows in figures 1-4 a display that includes a transparent holder that includes confetti therein, see column 5, lines 5-10. In view of the teachings of Borden it would have been obvious to one in the art to modify Lithwick by making the substance in the container in the form of confetti since this would create a more amusing and aesthetically pleasing display.

Claims 26-29 and 45-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jacobson et al. (U.S. Patent No. 3,191,340) in view of Hirsch (U.S. Patent No. 6,484,425).

In regard to claims 26 and 47, Jacobson et al. does not disclose the idea of placing liquid in the container. Hirsch shows in figures 1-4 a display that includes an aperture in a sheet which receives a transparent container (11) which includes a liquid and particles therein. Hirsch discloses in column 4, lines 15-20 that the particles can be glitter, plastic strips, colored plastic, sponge, rubber, metal, beans, pellets, etc. In view of the teachings of Hirsch it would have been obvious to one in the art to modify Jacobson et al. by placing a liquid within the container since this would create a more amusing and aesthetically pleasing display. In regard to claims 27 and 48, in view of the teachings of Hirsch it would have been obvious to one in the art to modify

Lithwick by placing a liquid having particles within the container since this would create a more amusing and aesthetically pleasing display. In regard to claims 28 and 46, Jacobson et al. does not disclose the idea of making the substance within the container in the form of confetti. Hirsch shows in figures 1-4 a display that includes an aperture in a sheet which receives a transparent container (11) which includes a liquid and plurality of particles therein. Hirsch discloses in column 4, lines 15-20 that the particles can be glitter, colored plastic, pellets, chips, etc. The use of confetti is well known in the art. In view of the teachings of Hirsch and the fact that confetti is conventional in the art it would have been obvious to one in the art to modify Jacobson et al. by making the substance in the container in the form of confetti since this would create a more amusing and aesthetically pleasing display. In regard to claims 29 and 45, Jacobson et al. does not disclose the idea of making the substance within the container in the form of glitter. Hirsch shows in figures 1-4 a display that includes an aperture in a sheet which receives a transparent container (11) which includes a liquid and particles therein. Hirsch discloses in column 4, lines 15-20 that the particles can be glitter. In view of the teachings of Hirsch it would have been obvious to one in the art to modify Jacobson et al. by making the substance in the container in the form of glitter since this would create a more amusing and aesthetically pleasing display.

Claim 46 is rejected under 35 U.S.C. 103(a) as being unpatentable over Jacobson et al. (U.S. Patent No. 3,191,340) in view of Borden (U.S. Patent No. 5,197,213).

Jacobson et al. does not disclose the idea of making the substance within the container in the form of confetti. Borden shows in figures 1-4 a display that includes a transparent holder that includes confetti therein, see column 5, lines 5-10. In view of the teachings of Borden it would

Art Unit: 3611

have been obvious to one in the art to modify Jacobson et al. by making the substance in the container in the form of confetti since this would create a more amusing and aesthetically pleasing display.

Response to Arguments

Applicant's arguments filed March 8, 2005 have been fully considered but they are not persuasive.

The applicant argues that Lithwick does not show or suggest two distinct containment sheets as required in claim 1. The examiner notes that the applicant's elected species shown in figure 2 does not contain two distinct sheets in the sense that one of the containment sheets (28) is a portion of the "sheet" which also includes sheet segments (21,22) which form the greeting card. Further, the applicant does specifically state that the two containment sheets are distinct from one another. As broadly defined in claim 1, the first and second panels (25,26) of Lithwick are considered to be first and second "sheets".

In regard to the applicant's arguments with regard to claims 24 and 41, these arguments are moot in view of new reference (Jacobson et al.) applied with regard to these claims.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO**

Art Unit: 3611

MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian K. Green whose telephone number is (571) 272-6644. The examiner can normally be reached on M-F 7am-3:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lesley Morris can be reached on (571) 272-6651. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


BRIAN K. GREEN
PRIMARY EXAMINER

Bkg
Sept. 6, 2005